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10/036,286

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EXAMINER

APPLE, KIRSTEN SACHWITZ

ART UNIT

PAPER NUMBER

3693

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/036,286

Applicant(s)

KUMAR ET AL.

Examiner

Kirsten S. Apple

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims 1-22+30-35

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected. 1-22+30-35
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This action is in response to the application response filed on 2/20/07.

Claim Rejections - 35 USC § 112

In view of the applicants amendments the 112 rejections is hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-35 are

rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular it is indefinite and the examiner did not understand:

“segments of receipts” as presented it at least the depend claims.

It is unclear to the examiner and one of ordinary skill in the art what is claim by this description. Does this mean if I have a grocery bill with 10 items you are collecting “receipts” you are looking for all the grocery bills that have the item bananas?

The examiner will use “segments of receipts” to review the claims but further definition is needed.

If this is the interpretation then there is an enablement issue. Where do you get the receipt information and how do you process it? If as your spec says you are a financial services company selling credit cards are you looking at the credit card statement (this is enabled because

it is understandable how this happens) but your claims does not specify this it would read on a grocery store print advertisement and a grocery store receipt. How would this be done?

In addition Claims 1-22 are
rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At least the independent claims last step lacks "real world result" the last step is "determining".. "segments that may be used to satisfy said at least one criterion." This is something that could be done in someone's head and not a physical action in the real world. "print a report" or "sending new marketing materials or offers" to selected customers would be examples of real world results. Correct action is needed.

Claim Rejections - 35 USC § 103

The Examiner has read and reviewed all of the information provided by the Applicant.
The examiner rejects as final claims 1-35 under 35 USC 103.

The Applicant attention is re-drawn to the following:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lancaster (U.S. Patent Publication 2002/0194094 A1) in view of Kotler (Marketing Management)

Re claim 1, 23, 30, 31, : Lancaster discloses:

A method for identifying recipients of communication & promoting financial products comprising:

Providing a first communication of financial product (see Lancaster, Figure 1, pre-item 305, it is inherent that there was some form of communication for them to know about the base product)

Determining segments of receipts, including recipients having and associated response rate (see Lancaster, Figure 1, item 310)

Determining at least one criterion associated with communication (see Lancaster, Figure 1, item 310)

Determining marketing segments to satisfy criterion (see Lancaster, Figure 1, item 310)

Providing a second communication to a member of the marketing segments (see Lancaster, Figure 1, item 315)

The examiner believes that determining segments of receipts is simply identifying a market segment and inherent in “analyze customer info” However, to make the record clear, should it be interpreted that Lancaster does not have marketing segments, Kotler claims “marketing segments” (see Kotler, page 278 – 306 – specifically 278 & financial services case example of BOA page 293-294.)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Marketing segments as taught in Kotler to Lancaster.

It is clear that one would be motivated because more exact form of analyzing to improve sales revenue.

Re claim 2, 17: Lancaster discloses:

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Determining marketing segments or information include one of the following:

Receiving credit history (see Lancaster, Figure 1, item 150)

(the below additional items may also be in the prior art but one references is sufficient)

Receiving list of potential recipients

Receiving demographic info

Receiving lifestyle info

Receiving credit performance

Re claim 3, 6: Lancaster discloses:

Determining marketing segments include one of the following:

Determining a score (see Lancaster, Figure 6B, FICO Score)

(the below additional items may also be in the prior art but one references is sufficient)

Determining responses

Re claim 4, 11: Lancaster discloses:

Determining criterion:

Receiving data of criterion (see Lancaster, Figure 2, Item 220)

Re claim 5, 19: Lancaster discloses:

Determining marketing segments or info include one of the following:

Selecting marketing segment of members to which can be sent for a cost less than a max cost required by criterion & maximum allowable cost associate with communication (see Lancaster, Figure 5 & Figure 6A & paragraph 71)

(the below additional items may also be in the prior art but one references is sufficient)

Selecting marketing segment that provide & desired minimum response rates

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Selecting marketing segment & desired minimum & maximum recipient pool size

Re claim 7, 28 & 29: Lancaster discloses:

Determining an indicative characteristic of marketing segments

Marketing segments include persons with indicative characteristics. (see Lancaster, Figure 2, item 220 + Kotler page 279)

Re claim 8, 21, 26, 27 & 32: Lancaster discloses:

Providing & selecting communication & first communication & second communication (see Lancaster, Figure 2, item 210 & 230)

Re claim 9: Lancaster discloses:

Providing notification of marketing segments that satisfy criterion (see Lancaster, Figure 5, item 550 + Kotler page 279)

Re claim 10, 24, 25: Lancaster discloses:

Communication & first communication & second communication comprises:

Email (see Lancaster, Figure 4B, item 470 + paragraph 79)

(the below additional items may also be in the prior art but one references is sufficient)

Instant message

Letter

Electronic signal

Message sent to postal address

Wireless transmission

Re claim 12: Lancaster discloses:

Format and content of failure report selectable (see Lancaster, Figure 4B, item 480)

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Re claim 13, 18: Lancaster discloses:

Determining behavior & info include one of the following:

Use of a financial product (see Lancaster, Figure 2, item 220 + Kotler page 293

“monitor large deposit”)

(the below additional items may also be in the prior art but one references is sufficient)

Incremental use of a financial product

Purchase of a product with a financial product

Signing up for a credit card

Agreeing to accept a credit card

Re claim 14: Lancaster discloses:

Designated behavior includes:

Incremental use of a financial product over non-recipients of communication (see

Lancaster, Figure 2, item 220 + Kotler page 293 “monitor large deposit”)

Re claim 15: Lancaster discloses:

Financial product includes one of the following:

Credit card

Debit card

The examiner sites “official notice” that a credit card or debit card would be a financial product

Re claim 16: Lancaster discloses:

Determining info regarding potential recipients (see Lancaster, Figure 2, item 220)

Re claim 20: Lancaster discloses:

Determining potential recipients (see Lancaster, Figure 2, item 220 + Kotler page 279)

Re claim 20: Lancaster discloses:

Communication includes an offer regarding a financial product (see Lancaster, Figure 2, item 230)

Re claim 29: Lancaster discloses:

Marketing segments include person of recipients that has an indicative characteristic associated (see Lancaster, Figure 2, item 220 + Kotler page 279+)

Examiner Remarks

This application appears to have not unique invention beyond basic “marketing marketing segmentation theory” which has been know and employed by firms for years in many industries. For example the spec defines communication as “web based advertising” a criterion would be clicking through to the web site or once clicking through ordering something. Charging web advertising based upon “click thought” is well know in the art prior to the date of invention. This is just one additional example that would read on this invention. The examiner would like to reiterate that this is basis Marketing 101 course material. While the examiner sited some references in the action there are an unlimited number of references that would read on the limitations as they are currently presented in the application.

Response to Arguments

Applicant's arguments filed 2-20-07 have been fully considered but they are not persuasive.

In particular, and respect to Claim 1 the Applicant argued 1st: Kotler “market segments” is not the same as the newly amended claims of “segments of recipients”

The Examiner refutes the argument made by the Applicant and draws the attention to Kotler, which clearly has market segmentation. The examiner would once again note that there is a 112 rejection on this claim because "segment of recipients" is unclear and lacks enablement. While the applicant is arguing that this "segments of receipts" - the "determining plurality of segments" is based on the description in the spec is to market to those CUSTOMER that responded to advertisement ie market segmentation. Having receipts not connected to a customer is of no value (if there is value to this it needs to be specified in the spec or claims) which is why there is a 112 rejection. The Examiner believes as the claims current stand "segments of recipients" reads on Lancaster in view of Kotler.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa

 5/14/07
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